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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/426,011	10/25/1999	MICHAEL SIMONS	BI0004US.P1	1306

7590 04/12/2007
JANE MASSEY LICATA, ESQ.
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Marlton, NJ 08053

EXAMINER

TELLER, ROY R

ART UNIT	PAPER NUMBER
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1654

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/426,011	SIMONS ET AL.	
	Examiner	Art Unit	
	Roy Teller	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the amendment, received 12/21/06, in which applicant amended claim 11.

Claims 11, 15 and 16 are under examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11, 15 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 7,202,217. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11, 15 and 16 in the instant application disclose a PR-39 derived oligopeptide family whose members individually cause a selective inhibition of proteasome-mediated degradation in-situ after introduction to a viable cell, and each member being an oligopeptide consists of a

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peptide of 8 to 11 amino acid residues in length with the N-terminal amino acid sequence of Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr (SEQ ID NO: 5). The '217 patent recites an isolated PR-39 derived oligopeptide consisting of the amino acid sequence Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr (SEQ ID NO: 6). See, i.e., for example, claim 16. This reads on the limitations of instant claims 11 and 16. Instant claim 15 is drawn to a PR-39 derived oligopeptide family whose membership includes a peptide of 11 amino acid residues and whose sequence is Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr-Leu-Pro-Arg (SEQ ID NO: 4). The '217 patent recites an isolated Pr-39 derived oligopeptide consisting of the amino acid sequence Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr-Leu-Pro-Arg (SEQ ID NO: 5). See, i.e., for example, claim 16. This reads on the limitations of instant claim 15.

Claims 11, 15 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10, 12 and 13 of U.S. Patent No. 7,202,212.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11, 15 and 16 in the instant application disclose a PR-39 derived oligopeptide family whose members individually cause a selective inhibition of proteasome-mediated degradation in-situ after introduction to a viable cell, and each member being an oligopeptide consists of a peptide of 8 to 11 amino acid residues in length with the N-terminal amino acid sequence of Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr (SEQ ID NO: 5). The '212 patent recites a family of PR-39 derived oligopeptides whose membership individually cause a selective inhibition of proteasome mediated degradation in-situ after introduction intracellularly to a viable cell. See, i.e., for example, claim 10. This reads on the limitations of instant claim 11. The '212 patent recites the Pr-39 derived oligopeptide family whose membership include a peptide

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comprised of 11 amino acid residues whose sequence is Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr-Leu-Pro-Arg. See, i.e., for example, claim 12. This reads on the limitations of instant claim 15. The '212 patent recites the Pr-39 derived oligopeptide family whose membership include a peptide comprised of 8 amino acid residues whose sequence is Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr. See, i.e, for example, claim 13. This reads on the limitations of instant claims 11 and 16.

Conclusion

All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy Teller whose telephone number is 571-272-0971. The examiner can normally be reached on Monday-Friday from 5:30 am to 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/28/07

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ANISH GUPTA
PRIMARY EXAMINER